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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/953,154	10/17/1997	KEITH A. KOZAK	450.154US1	3463
7590 11/18/2004			EXAMINER	
SCHWEGMAN LUNDBERG WOESSNER & KLUTH			VORTMAN, ANATOLY	
P O BOX 2938			ART UNIT	
MINNEAPOLIS, MN 55402			PAPER NUMBER	
			2835	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/953,154

Applicant(s)

KOZAK ET AL.

Examiner

Anatoly Vortman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004 (Appeal Brief).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11,13-18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-17,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Appeal Brief***

1. In view of the Appeal Brief filed on 10/09/04, PROSECUTION IS HEREBY REOPENED. Non-final rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, are rejected under 35 U.S.C. 102(b) as being anticipated by US/5,268,675 to Garthwaite et al., (Garthwaite).

Regarding claim 1, Garthwaite disclosed (Fig. 1-6C) a keyboard (3) comprising: a housing defining a non-integral personal computer keyboard; a plurality of keys disposed within the housing; a communications link disposed within the housing, wherein the communications link is capable of communicating with a computer (column 3, lines 52+); and, a connector (52) operatively coupled to the communications link, said connector (52) disposed within the housing and receptive to a corresponding connector (22) of a device (10) such that the device (10) communicates with the computer over the communications link when the connectors are coupled.

Regarding claims 2-4, Garthwaite disclosed that the housing has a plurality of surfaces (54) defining a cradle cavity (50) into which the connector (52) is disposed, the cradle cavity (50) shaped so that the device (10) fits into the cavity such that at least one surface (top and / or front) of the device is exposed.

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Regarding claim 5, Garthwaite disclosed that the housing has an end surface into which the connector is disposed (52), the connector (22) of the device (10) coupling the connector of the housing (52) such that at least a top surface of the device (10) is flush with a corresponding surface of the housing (Fig. 7C, when said device (10) is positioned perpendicularly to the supporting surface, (i.e. at the 90° angle to the top surface of the keyboard)).

4. Claims 17, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by US/5,835,732 to Kikinis et al.

Regarding claim 17, Kikinis disclosed (Fig. 20) a keyboard (151) comprising: a housing defining a non-integral personal computer keyboard; a plurality of keys disposed within the housing; a communications link disposed within the housing to communicatively couple the keyboard to the computer; and, a communications link disposed within the housing, wherein the communications link is capable of communicating with a computer (inherently, the link connects device (10) to a computer via keyboard); and, a connector disposed within the housing (inherently, for connecting cable (153) to the keyboard's circuitry) and receptive to a corresponding connector (the connector of the device (10) which accepts the plug (20)) of a personal digital assistant (PDA) device (10) such that the PDA device (10) communicates with the computer over the communications link when the connectors are coupled.

Regarding claim 20, Kikinis disclosed (Fig. 20) a computer keyboard (151) comprising: a housing defining a non-integral personal computer keyboard; a plurality of keys disposed within the housing; a communications link disposed within the housing, wherein the communications

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link is capable of communicating with a computer (inherently, the link connects device (10) to a computer via keyboard), and a connector disposed within the housing (inherently, for connecting cable (153) to the keyboard's circuitry) and receptive to a corresponding connector (the connector of the device (10) which accepts the plug (20)) of a device (10) having a touch screen (16), (column 4, lines 56+), such that the device (10) communicates with the computer over the communication link when the connectors are coupled.

Regarding claim 21, Kikinis disclosed that the housing has an end surface into which the connector is disposed (inherently, for connecting cable (153) to the keyboard's circuitry), the connector (20) of the device (10) coupling the connector of the housing such that at least one of a top surface and a bottom surface of the device (10) is flush with the corresponding surface of the housing (since cable (153) is flexible, the device (10) may be positioned such that its top or bottom surface may be flush with the surface of the keyboard).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garthwaite in view of Kikinis ('732).

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Regarding claims 6-8, and 13, Garthwaite disclosed all, but that the communication link comprises at least a cable (USB-compatible cable) and / or a transceiver.

Kikinis disclosed (Fig. 1-6) a computer system with a keyboard (60) having communication link (26') for communicating with the computer system, wherein said communication link (26') may be implemented as a serial cable or wireless transceiver (column 1, lines 37+).

Since inventions of Garthwaite and of Kikinis are from the same field of endeavor (computer systems), the purpose of the serial cable and wireless receiver disclosed by Kikinis may be recognized in the invention of Garthwaite.

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to implement said communication link of Garthwaite with serial (USB) cable and / or wireless receiver, in order to provide plug-and-play capabilities and to enhance convenience for a user.

Regarding claims 9, 10, and 15, Kikinis disclosed a power source operatively coupled to the connector (14') of the keyboard to recharge a battery (15) of the device (10), (column 6, lines 3+).

Regarding claim 11, Kikinis disclosed that said device (10) is a PDA, operable in a docking mode or stand-alone mode (column 4, lines 46+; column 6, lines 3+).

Regarding claim 14, Kikinis disclosed that said device (10) has a touch screen (16) having at least one virtual key (column 4, lines 56+).

Regarding claim 16, Kikinis disclosed that said device (10) is a telephone handset, (column 14, lines 27+).

***Allowable Subject Matter***

7. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

claim recites: "the cradle cavity". The aforementioned limitations in combination with all remaining limitations of claim 18, are believed to render the claim patentable over the art of record.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

US/2002/0054024 disclosed (Fig. 2) a computer keyboard (18) with an attachable multipurpose auxiliary device (20).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 571-272-2047. The examiner can normally be reached on Monday-Friday, between 10:00 am and 6:30 pm..



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Lynn Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AV

A handwritten signature in cursive script, appearing to read "A. Vortman", followed by a horizontal line.

Anatoly Vortman  
Primary Examiner  
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